

PATENT APPLICATION
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of

Docket No: Q76452

Michel CHEVANNE, et al.

Appln. No.: 10/625,721

Group Art Unit: 2452

Confirmation No.: 8118

Examiner: Thomas J. Dailey

Filed: July 24, 2003

For: METHOD AND DEVICE FOR PROCESSING DATA FOR GENERATING ALARMS
WITHIN A COMMUNICATION NETWORK

REPLY BRIEF PURSUANT TO 37 C.F.R. § 41.41

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents

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Sir:

In accordance with the provisions of 37 C.F.R. § 41.41, Appellant respectfully submits
this Reply Brief in response to the Examiner's Answer dated December 10, 2009. Entry of this
Reply Brief is respectfully requested.

Table of Contents

STATUS OF CLAIMS.....	2
GROUND OF REJECTION TO BE REVIEWED ON APPEAL.....	3
ARGUMENT.....	4
CONCLUSION.....	12

STATUS OF CLAIMS

Claims 1-29 and 31-34 are all the claims pending in the application and are subject of this appeal.

Claim 30 has been previously canceled without prejudice or disclaimer and is not the subject of this appeal.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Ground 1

Claims 1-9, 13-23, and 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Larson (U.S. Patent Application No. 2003/0069848) in view of Weiss (U.S. Patent Application No. 2003/0217110).

Ground 2

Claims 10-12, 24-26, and 31-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Larson and Weiss in view of Stilwell (U.S. Patent No. 5,907,696).

ARGUMENT

In this Reply Brief, Appellants address below certain points raised in the Examiner's Answer as mailed on December 10, 2009.

Ground 1

Events in Weiss do not Constitute Data Having an Event Format

In maintaining the rejection of claims 1-9, 13-23, and 27-29 under 35 U.S.C. 103(a) as allegedly being unpatentable over Larson in view of Weiss, the Examiner maintains his position that events in Weiss, such as for example, an Internet telephony connection attempt or a receipt of an IM message allegedly corresponds to a plurality of different primary event formats, as recited in independent claims 1, 14, 15 and 28. In particular, the Examiner contends that it is unclear what precludes an event from being an event format and having data. *See Examiner's Answer at page 14.*

Weiss teaches "each event to be monitored need only be associated with one script file, and there need also be only one script file for each available alarm." *See Weiss at paragraph [0098].* In other words, in Weiss, events, and not event formats, are associated with script files. It goes without saying that the event itself, such as the Internet telephony connection attempt or the receipt of an IM message is not identical with data, which may represent such an event. In other words, a person of ordinary skill in the art would have known that there is a difference between an event, *i.e.*, the fact that somebody attempts to connect via Internet telephony, and data representing such an attempt, such as, for example a notification message, notifying a user about the attempt.

Weiss is silent about data representing an event and about respective event formats of such data. Although the Examiner maintains his position that an Internet telephony connection attempt or a receipt of an IM message allegedly correspond to event formats, the Examiner acknowledges that Weiss does not explicitly disclose or suggest a plurality of different primary event formats, as recited in claims 1, 14, 15 and 28. However, the Examiner now takes the position that Weiss inherently teaches this feature of claims 1, 14, 15 and 28, because, according to the Examiner, an event must allegedly be in a format and will have its own data. *See* Examiner's Answer at page 14. Appellants respectfully disagree with the Examiner's position.

The doctrine of inherency allows that extrinsic evidence may be consulted regarding an asserted inherent characteristic, but "[s]uch evidence must make clear that the missing descriptive matter is *necessarily* present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." *Continental Can Co. USA v. Monsanto Co.*, 948 F.2d, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991) (emphasis added) and MPEP § 2131.01. Moreover, inherency "may not be established by probabilities or possibilities." *Id.* at 1269. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) and MPEP § 2112.

"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original) and MPEP § 2112.

“The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted) and MPEP § 2112.

As established in the case law discussed above, if a structure in a cited reference does not expressly disclose a claimed feature, but absolutely must include that claimed feature in order to function properly, then that feature is deemed to be inherently disclosed. That is, the reference can only be treated as inherently including a feature if it **absolutely must** have the claimed feature. If there are two or more possibilities with respect to the non-disclosed feature, then the non-disclosed feature is not inherent.

In this case, Weiss does not inherently have to include a plurality of different primary event formats, as recited in claims 1, 14, 15 and 28. In Weiss, “[a]ny event, whether initiated by the present server appliance 10 or by another device, will be handled by software on the server appliance 10.” *See* Weiss at paragraph [0095]. An example of such a software which is directed to download e-mail at regular intervals is fetchmail. A particular script is added to fetchmail which contains a line, executing an alarm script. *See* Weiss at paragraph [0095]. “[E]very service would only need to call a single script programmed into it, and any alarm the user chose would be executed.” *See* Weiss at paragraph [0096].

In other words, when the fetchmail software determines that an event occurred, *i.e.*, an email was received, there is no need to create certain data in a primary event format, representing the event of a received email to be converted into secondary data of a secondary format. Instead, the software, namely fetchmail, which handles the receipt of the email, *i.e.*, the event,

immediately executes a script, which is now a part of the fetchmail program, and an alarm to the user is executed. The alarm can be playing a particular sound. *See* Weiss at paragraph [0095].

Although it might be possible in Weiss to send a supplemental alarm via an e-mail (*see* Weiss at paragraph [0093]) which might be interpreted as data representing the event in a primary event format, such a supplemental alarm is not necessary for Weiss to function properly.

In an exemplary embodiment of the present invention, each time an event occurs in an equipment, or in an apparatus supervised by this equipment, the latter delivers a notification representing the said event. *See* page 6, line 31 to page 7, line 8 of the specification as filed.

A data processing device receives from the equipment in a communications network, primary (or notification) data defining events in at least one primary format which is delivered to a management device as secondary data in a secondary format. *See* page 2, lines 18-24 of the Specification as filed. In other words, in the exemplary embodiment of the present invention, a plurality of notifications, *i.e.*, data defining events in a plurality of different event formats, are received and converted into secondary data of a secondary format.

More precisely, in the exemplary embodiment of the present invention described above, at least two structural elements are necessary, namely the device which detects or generates an event (the equipment of claim 1, for example) and thereafter generates primary data (notification) in a primary event format and the processing means, which receives the primary data and converts it into secondary data. Therefore, primary data with a plurality of different primary event formats may occur.

Since in Weiss, the software (*e.g.*, the fetchmail program), which detects the event, also generates the alarm, there is no need in Weiss to generate a notification, *i.e.*, primary data in a primary event format and to convert it in a secondary format. In other words, Weiss must not have the claimed feature and therefore Weiss does not inherently disclose or suggest a plurality of different primary event formats, as recited in claims 1, 14, 15 and 28.

Scripts in Weiss do not Contain Conversion Rules

Claim 1 recites and claims 14, 15 and 28 analogously recite “a plurality of conversion rules . . . associated with a plurality of different primary event formats . . . [and] each of the plurality of different primary event formats corresponds to a particular script.”

The Examiner contends that “since both Weiss and Larson disclose scripts, they disclose conversion rules (*i.e.*, the contents or code of the script).” *See* Examiner’s Answer at page 13, lines 14-16. The Examiner further alleges that in Weiss the “script file which would convert the event to a corresponding alarm, *i.e.* the alarm is a different format than the original event.” *See* Examiner’s Answer at page 14, lines 1-2.

However, merely from the fact that a reference teaches a script, a person of ordinary skill in the art would not have concluded that the script contains conversion rules being “associated with a plurality of different primary event formats, and arranged so as to convert, by means of said rules, primary data received in one of said primary formats into secondary data in said secondary format,” as recited in claims 1 and as analogously recited in claims 14, 15 and 28.

As discussed above, Weiss does not disclose or suggest, neither explicitly nor inherently, “a plurality of different primary event formats,” as recited in independent claims 1, 14, 15 and 28. Accordingly, there is no need in Weiss to convert event formats into secondary formats and therefore, no conversion rules are necessary.

Instead, as discussed above, each event in Weiss is directly associated with one script file (*see* Weiss at paragraph [0098]) and the script contains a line executing an alarm script, most likely playing a particular sound file (*see* Weiss at paragraph [0095]). However, executing an alarm script is clearly different from converting data from one format into a second format.

Finally, even assuming, *arguendo*, that one would have interpreted the execution of an alarm script as a conversion rule, such a conversion rule would convert an event (and not the representation of it in an event format) into an alarm. Therefore, contrary to the Examiner’s allegation, the script in Weiss does not contain a conversion rule as recited in Claims 1, 14, 15 and 28.

No Motivation to Combine Larson and Weiss

The Examiner contends that “[b]ecause both Larson and Weiss teach methods of converting events and network management, it would have been obvious to one skilled in the art to substitute one method for the other.” *See* Answer at page 11, lines 17-19. In addition, the Examiner contends that “one of ordinary skill and the inventors of the Larson system would not have limited the functionalities so narrowly as the appellant has framed it.” *See* Examiner’s

Answer at page 12, lines 11-13. Appellants respectfully disagree with the Examiner's contention.

There is no doubt that Larson relates to a business environment, in which network management systems (NMS) are used by information technology (IT) staff. *See* Larson at paragraphs [0004] and [0005].

Weiss teaches that “[i]n view of the intended use and the functionality offered by the present home gateway server appliance, the provision of an alarm system is a key distinction for a device intended for the home instead of a workplace environment.” *See* Weiss at paragraph [0016]. Thus, the device in Weiss, including the scripts, are not intended to be used in a workplace environment, such as for example, the environment of Larson. In other words, Weiss itself suggests against combining Weiss with a reference which teaches a workplace environment, such as Larson.

In addition, if the script in Larson, which is triggered after an alert is generated (*see* Larson at FIG. 6) is replaced by a script of Weiss, which is executed before an alarm is generated but after an event occurs in order to generate an alarm (which might be equivalent to the alert in Larson), such a modification would render the Larson reference unsatisfactory for its intended purpose.

The execution of the script in Larson results in an XML RPC which can be parsed by the application server. *See* Larson at paragraph [0129]. To the contrary, the execution of the script in Weiss results in an alarm, *i.e.*, in an alarm sound. There is no indication in Larson that the

application server would be able to parse an alarm sound. Even assuming, *arguendo*, that the script in Weiss generates a supplemental alarm sent via an e-mail (*see* Weiss at paragraph [0093]), there is no indication in Larson that the application server would be able to parse such a supplemental alarm sent via e-mail.

As a consequence, the modification suggested by the Examiner would render the Larson reference unsatisfactory for its intended purpose and therefore, a person of ordinary skill in the art would not have combined Larson and Weiss.

Claims 2-9, 13, 16-23, and 27 and 29 depend from claims 1, 15 and 28, respectively, and are patentable at least by virtue of their dependencies.

For at least the reasons stated here and in Appellant's Appeal Brief, the Examiner's rejection of claims 1-9, 13-23, and 27-29 under 35 U.S.C. § 103(a) is improper and should be reversed.

Ground 2

Regarding ground 2, the Examiner did not raise new issues. Instead, the rejection of claims 10-12, 24-26, and 31-34 is based on the same flawed analysis of Larson and Weiss, as applied by the Examiner to independent claims 1, 14, 15 and 28.

CONCLUSION

For the above reasons as well as the reasons set forth in Appeal Brief, Appellants respectfully request that the Board reverse the Examiner's rejections of all claims on Appeal. An early and favorable decision on the merits of this Appeal is respectfully requested.

Respectfully submitted,

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